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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/820,735 | 04/09/2004 | Hirotooshi Tawara | 250056US-3DIV | 8994 |

22850 7590 05/16/2005

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| EXAMINER |
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SPISICH, MARK

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| ART UNIT | PAPER NUMBER |
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1744

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,735

Applicant(s)

TAWARA ET AL.

Examiner

Mark Spisich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 and 14-18 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 April 2005 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the concavo-convex portion of the rotating body (claims 6 and 14) and similarly the rotating body having a radius that varies along the axis of rotation thereof (claim 1) must be shown or the feature(s) canceled from the claim(s). This is especially important in that these limitations are now the alleged distinguishing limitations with respect to the prior art. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5, 11-13, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Page 3 (lines 24-30) and page 9 (lines 7-19) as well as at least one of the original claims in the parent application (09/984,766) describe the rotating body (18) as having a concavo-convex portion. This portion may be provided, for example, "by applying a rib, a convex portion, a recess portion, a crimping surface or the like to the surface of the contact rotating body 18." (page 9, lines 18 and 19). There is no drawing or figure to illustrate this portion of the

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body. The original specification is vague as to the manner of applying the ribs, etc. to the body. Such could be applied as ribs extending along the full length of the body. Such would not result in the radius that varies along the axis of rotation thereof (as is now claimed in claim 1). In short, the original specification and drawings do not describe the claim limitation (claim 1) with sufficient specificity to support such a recitation. The specification does support the recitation of the different scraping up bodies (claim 11) (page 13, line 29-31) as well as the different portions of the rotating body (claim 12) (page 9, lines 17-19) ; however, there is no support for the recitation of “**at least one of**” in either claim. Such a recitation specifically includes combinations of elements not anticipated by the original specification. A deletion of “at least” in each of claims 11-13, 19 and 20 (line 2) would be sufficient. Claim 6 (line 3) includes a recitation of “a scraping up body **having an abrasive surface**” (emphasis added). This limitation was added in a prior amendment in order to define over the prior art (which including a tacky roller). It was originally assumed by the examiner that this was a broad reference to the brush. Although there is support for the recitation of the different scraping up bodies of claim 11, there is no support for the recitation of many of them along with the recitation that they have a abrasive surface (which is required by claim 6, from which claim 11 depends). For example, a sponge is NOT abrasive and would not normally be described as such. The deletion of the phrase “having an abrasive surface” (claim 6, line 3) would be acceptable.

Response to Arguments

5. The examiner acknowledges the personal interview with applicant's representatives. Applicant has thus amended the claims to recite (at least to some degree) the disclosed "concavo-convex portion" of the rotating body (18). This aspect of the invention is described at page 3 (lines 25-30) and page 9 (lines 17-19). The terminology added to claim 1 (having a radius that varies along an axis of rotation) is at least lacking antecedent support in the specification. The specificity of the description with regard to the concavo-convex portion of the body (18) does not appear to be sufficient to support the language added to claim 1. The absence of a drawing or illustration of this aspect of the invention makes things worse, especially given the fact that this (the concavo-convex portion) feature is now the primary limitation that defines over the prior art. The inclusion of "having a concavo-convex portion" into claim 6 as well as new claim 14 is not objected to with regard to the terminology (there is support in the specification for such a term); however, such a limitation must be shown in the drawings (without introducing new matter into the application).

Allowable Subject Matter

6. Claims 6-10 and 14-18 are allowed over the prior art of record, with the stipulation that the "concavo-convex portion" of the rotating body (18) must be shown in the drawings (without introducing new matter into the application).

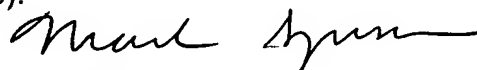
7. With regard to claims 11, 12, 19 and 20, applicant's attention is directed to the suggestions made in paragraph #4 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Spisich
Primary Examiner
Art Unit 1744

MS